

REMARKS

Claims 7-26 are pending in the instant application. The Examiner requires that Applicants select one of the following groups of claims for examination:

- Group I. Claim(s) 7-9 and 12, drawn to a method for the treatment and/or prophylaxis of carcinoma by administering an agent which interacts with or modulates the expression or activity of a MAL2 polypeptide.
- Group II. Claim(s) 10 and 1 I, drawn to a method for the treatment and/or prophylaxis of carcinoma by administering a MAL2 polypeptide.
- Group III. Claim(s) 13, 14, 24, and 25, drawn to a method of screening for anticarcinoma agents that interact with a MAL2 polypeptide.
- Group IV. Claim(s) 15-17, drawn to a method of screening for anti-carcinoma agents that modulate expression or activity of a MAL2 polypeptide.
- Group V. Claim(s) 18, drawn to an agent.
- Group VI. Claim(s) 19-23, drawn to a method of diagnosing carcinoma by detecting the expression of a MAL2 polypeptide.
- Group VII. Claim(s) 26, drawn to a kit comprising a capture reagent specific for a MAL2 polypeptide.

Applicants herein elect Group VI, claims 19-23, drawn to a “method of diagnosing carcinoma by detecting the expression of a MAL2 polypeptide” with traverse. Applicants respectfully request reconsideration of the Requirement for Restriction to allow prosecution of all groups of claims designated by the Examiner in the present Application, for the reasons provided as follows.

Under 35 U.S.C. §121 "two or more independent and distinct inventions ... in one Application may ... be restricted to one of the inventions." Inventions are "'independent'" if "there is no disclosed relationship between the two or more subjects disclosed" (MPEP 802.01). The term "'distinct'" means that "two or more subjects as disclosed are related ... but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE OVER EACH OTHER" (MPEP 802.01) (emphasis in original). However, even with patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

Further, under Patent Office Examining Procedures, "[i]f the Search and Examination of an entire Application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions" (MPEP 803, Rev. 8, May 1988) (emphasis added).

Applicants respectfully submit that the groups designated by the Examiner fail to define compositions and methods with properties so distinct as to warrant separate Examination and Search. The Examiner's assertions to the contrary notwithstanding, Applicants respectfully submit that conjoint examination and inclusion of all of the claims of the present application would not present an undue burden on the Examiner, and accordingly, withdrawal of the Requirement for Restriction, is in order.

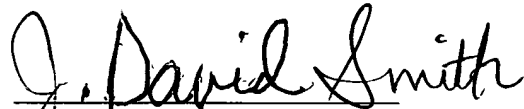
FEES

It is believed that no fees are necessary in connection with the present submission; however, should this be in error, authorization is hereby given to charge Deposit Account No. 11-1153 for any underpayment or to credit any overage.

CONCLUSION

It is believed that all of the claims are patentable and early notification as such is earnestly solicited. If any issues may be resolved by way of telephone, the Examiner is invited to call the undersigned at the telephone number indicated below.

Respectfully submitted,

A handwritten signature in black ink, reading "J. David Smith". The signature is written in a cursive style with a large, stylized "J" and "S".

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